



UNITED STATES DEPARTMENT OF COMMERCE
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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/360,805	07/23/99	CLUM	JBP-462

HM12/0222

JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 88933-7003

EXAMINER

HOLLINDEN, G

ART UNIT	PAPER NUMBER
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1616

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DATE MAILED: 02/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/360,805

Applicant(s)

CLUM ET AL.

Examiner

Gary E Hollinden, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-63 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 16-63 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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The reissue oath/declaration filed with this application is defective because the error, which is relied upon to support the reissue application, is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) as well as MPEP § 1414 and § 1450. In particular, failure to timely file a divisional application is not considered to be error causing a patent granted to be partially inoperative by reason of claiming less than they had a right to claim. In the instant case, the added claims are not directed to any invention disclosed in the original patent as evidenced by the claims in the original patent.¹ The newly added claims are directed to processes of making a composition while the original claims were drawn to a composition. In addition, the new claims are not drawn to a process of making the same composition that was patented but rather one of a much different scope.

Since this application is not based on proper grounds for filing, it has not been further treated on the merits.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary E Hollinden, Ph.D. whose telephone number is 703/308-4521. The examiner can normally be reached on 6:30am to 3pm, Monday through Friday.

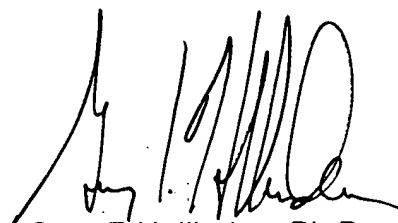
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703/308-4628. The fax phone numbers for

¹ *In re Rowland* 187 USPQ 487 (CCPA 1975)

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the organization where this application or proceeding is assigned are 703/308-4556 for regular communications and 703/308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1235.

A handwritten signature in black ink, appearing to read "Gary E. Hollinden", is written over the typed name.

Gary E Hollinden, Ph.D.
Primary Examiner
Art Unit 1616

GEH
February 17, 2000